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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/819,965	03/28/2001	Takao Yoshimine	275745US6	4221

22850 7590 03/08/2006

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EXAMINER	
CHAMPAGNE, DONALD	
ART UNIT	**PAPER NUMBER**
3622	

DATE MAILED: 03/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/819,965	YOSHIMINE ET AL.	
	Examiner	Art Unit	
	Donald L. Champagne	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *37-43,45-54,56-65,67-69 and 97* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *37-43,45-54,56-65,67-69 and 97* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 March 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed with an amendment on 14 December 2005 have been fully considered but they are not persuasive. The arguments are addressed in the following final rejection.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "A refund quantity to be earned by the content creator" is new matter (at line 7 in claim 37, in similarly in the other independent claims). It is also bad English. First, the word "refund" does not appear in the specification. Said "refund" is presumably intended to be a synonym for the disclosed phrase "profit give back", but that is itself bad English for a share of the profits or revenues, which are commonly called royalty payments. A refund is a give back, which is to say a return (Merriam-Webster's collegiate dictionary). The content creator never provided anything to be given back, so the content creator cannot receive a "refund" or a "give back".

Specification

4. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 37-43, 45-54, 56-65, 67-69 and 97 are rejected under 35 U.S.C. 103(a) as being obvious over Logan et al. (US005721827A) in view of Hammons et al. (US006477509B1).

7. Logan et al. teaches (independent claims 37, 48, 59 and 97) an apparatus, method and program for determining a refund, the method comprising: accessing and transmitting, via a network (col. 4 line 13 and Fig 1) selected content data (*programming*), provided by a content creator (*content provider*, col. 6 line 8) to one or more user locations (*players **103***, col. 2 line 63 to col. 3 line 9), in response to a request from the one or more user locations for the selected content data/*programming* (col. 6 lines 45-51); calculating "a refund quantity to be earned by the content creator" (royalties to be paid to the content provider) as a function of the number of transmissions of the selected content data/*programming* (col. 20 lines 3-20); storing and accumulating "the refund quantity to be earned by the content creator" (royalties to be paid to the content provider) in a content creator information database (*account number of the content provider*, col. 17 lines 15-19) and determining the *credits*, which reads on a plurality of levels of an entitled refund the refund quantity translates to, wherein said plurality of levels/*credits* of an entitled refund includes a fee credit (the reduction in *subscription cost*).

8. Logan et al. also teaches calculating "a refund quantity to be earned by the content creator" (royalties to be paid to the content provider) as a function of whether the selected content includes advertising data when a content provider is also an advertiser (col. 21 lines 2-4).

9. The examiner could not find "a plurality of levels" disclosed in the spec. The spec. does disclose "the number of points" (para. [0383] of the published application, US 20020046097A1), which the examiner accepts as substantially equivalent to "a plurality of levels". Hence *credits* in Logan et al. corresponds to the disclosure of "the number of points" as well as corresponds to the claimed "a plurality of levels".

10. Logan et al. does not teach that said refund includes merchandise. Logan et al. does teach that said refund/*credits* comprises an *incentive* for accepting advertising (col. 7 lines 60-63). Hammons et al. teaches that said refund/*incentive* includes merchandise, especially merchandise sold by the advertisers (col. 2 lies 15-18). Because Hammons et al. teaches that this will increase income of the system operator (col. 1 lines 27-30 and col. 3 lines 24-26), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Hammons et al. to those of Logan et al.

11. Logan et al. also teaches at the citations given above claims 38, 49 and 60; claims 40-41, 51-52 and 61-62, where *subscription cost* (col. 10 line 1) reads on connection fee and use fee.

12. Logan et al. also teaches at the citations given above claims 39, 50 and 61 (col. 9 lines 5-11); claims 42, 53 and 64 (col. 9 lines 62-63); and claims 47, 58 and 69, where *royalty payments due to content providers* (col. 15 lines 40-41) reads on contributions.

13. Hammons et al. teaches claims 43, 54 and 65 (col. 3 lines 18-23).

14. Neither reference teaches (claims 46, 57 and 68) that the ad is placed at the head (beginning) of the content. Because it is common practice to begin programming with advertising, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to the teachings of Logan et al. that the ad is placed at the head (beginning) of the content.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

16. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.

18. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

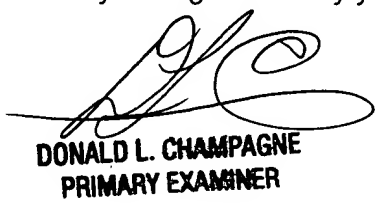
19. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

20. **AFTER FINAL PRACTICE** – Consistent with MPEP § 706.07(f) and 713.09, prosecution generally ends with the final rejection. Examiner will grant an interview after final only when applicant presents compelling evidence that "disposal or clarification for appeal may be accomplished with only nominal further consideration" (MPEP § 713.09). The burden is on applicant to demonstrate this requirement, preferably in no more than 25 words. Amendments are entered after final only when the amendments will clearly simplify issues, or put the case into condition for allowance, clearly and without additional search or more than nominal consideration.

21. Applicant may have after final arguments considered and amendments entered by filing an RCE.

22. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last

Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.



Donald L. Champagne
Primary Examiner
Art Unit 3622

6 March 2006